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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/718,128  | 11/19/2003  | James T. Olsta       | 28570/10087         | 9107             |
| 4743  | 7590        | 04/03/2006           | EXAMINER            |                  |
| MARSHALL, GERSTEIN & BORUN LLP<br>233 S. WACKER DRIVE, SUITE 6300<br>SEARS TOWER<br>CHICAGO, IL 60606 |             |                      | MENON, KRISHNAN S   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1723                |                  |

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/718,128

Applicant(s)

OLSTA ET AL.

Examiner

Krishnan S. Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-29 and 35-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-44 are pending, of which claims 1-11 and 30-34 are withdrawn from consideration.

### ***Election/Restrictions***

Claims 1-11 and 30-34 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/16/06.

Applicant's election with traverse of claims 12-29 in the reply filed on 3/16/06 is acknowledged. The traversal is on the ground(s) that a search for the method features necessarily requires a search for the article claims. This is not found persuasive because the product can be made by a materially different process such as mixing geotextile fibers with the active ingredients before laying or casting. The process also is useful for making a materially different product such as breathable wearable fabrics for hazardous environments.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Objections***

Claim 38 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 12. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is

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proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 12, 13 and 35-44 are rejected under 35 U.S.C. 102(b) as being anticipated by White (US 5,237,945).

Claims 12, 13, 38: White'945 teaches a method of manufacturing a geotextile mat by pre-forming the mat, then filling the voids in the mat with the active material, then adhering a liquid-permeable cover-sheet (woven or non-woven) on the mat with a water insoluble (solvent-based) adhesive to one or both major surfaces as claimed. See figures 1-3, abstract, column 3 lines 31-55, column 7 line 60 – column 8 line 33 and column 10 lines 15-28. Regarding the opening size of the mat, see column 8 lines 10-13 and 22-32: porosity sufficient to receive the particles; particle sizes 0.02-15 mm. With respect to the limitation of 'preformed geotextile mat', the geotextile mat in the reference is formed on the machine before filling the powders, and thus is 'pre-formed'.

Claims 35, 37: zeolite, etc – column 3 lines 40-50.

Claims 36,42: fiber materials: polyester, etc. – see column 17 lines 1-30.

Claim 39: particle mesh size – see column 8 lines 22-32.

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Claims 40, 41: Reference teaches fiber density in the mat at 1-50 oz/sq ft (column 8 lines 14-20) and powder filling at ¼ to 30 lbs/sq.ft. (column 13 lines 45-52), which would show that the volume % of the powder falls in the ranges claimed.

Claims 43 and 44: the mat and the cover sheets are non-woven as claimed: mat is laid as non-woven. The sheet is non-woven – see column 10 lines 15-20.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over White'945.

Claim 22 differs from the teaching of the reference in that the second layer of geotextile mat is formed in situ and adhered on the first layer of geotextile mat; the claim recites a pre-formed mat is adhered over the first layer. However, this difference would not make the claim patentable because it only eliminates the process steps of making the mat elsewhere and then bringing it in to apply over the first layer. Omission of an Element and Its Function Is Obvious If the Function of the Element Is Not Desired. Ex parte Wu , 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989). See also In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) and In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

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Adhering second and subsequent layers of geotextile mat, including partially or wholly filled layers, and cover sheets, are taught in figure 6 a-c, and column 13 line 19 – column 14 line 35, column 15 lines 1-27.

3. Claims 14-16 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over White'945 as applied to claim 12 above, and further in view of White (US 5,346,565) and/or Clarey et al (US 5,900,085).

Instant claims differ from the teaching of White'945 in the process of covering of all edges as claimed. However, covering the edges to prevent fall out of the filler material by sewing the edges together, needle-punching, gluing, etc are known in the art, as seen in White'565 and Clarey, and is unpatentable. See White'565 column 1 lines 35-58 and Clarey column 2 lines 46-67.

4. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over White'945 as applied to claim 12 above, and further in view of Zhou et al (US 6,610,781).

Instant claims differ from the teaching of White'945 in the step of vibration or vacuum to spread the powder into the mat. Zhou teaches vibration or vacuum for spreading a powder into a porous substrate for distributing the powder in the substrate (see claim 7 of Zhou and column 10 line 57 column 11 line 4). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Zhou in the

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teaching of White'945 to have vibration or vacuum applied for distributing the powder intimately into the porous mat.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Krishnan S. Menon  
Patent Examiner  
3/30/06